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(FRI)MAR 14 2008 13:49/ST.13:46/NO. 6302335876 P 13

Atty Docket No.: 200300232-1

Remarks

This communication is responsive to the Final Office Action of January 3, 2008. Reexamination and reconsideration of claims 1-15, 30-42, and 49-54 is respectfully requested.

Summary of The Final Office Action

The previous rejections based on §102 and §103 were withdrawn. No rejections based on prior art remain in the application.

Claims 1, 30, 36 and 49 were rejected under 35 U.S.C. 112, first paragraph, because the specification is purportedly not enabling.

Dependent claims 2-15, 31-35, 37-42, and 50-54 were rejected on 35 USC 112, 1st paragraph, also because they inherit the §112 rejection from their respective independent claims.

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Premature Final Rejection, Request to Withdraw

Applicant respectfully submits that the Final Rejection is premature and should be withdrawn. Filed with the present response is a Petition to the Director to review and withdraw the final rejection.

In particular, no claim amendments were made in the previous response but the present Office Action now introduced a new ground of rejection (under 35 U.S.C. 112, first paragraph). A final rejection in this scenario is not permitted by MPEP 706.07(a), second paragraph: "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims ..." [emphasis added]. Accordingly, Applicant requests that the final rejection be withdrawn.

35 U.S.C. §112, first paragraph, rejection

Independent claims 1, 30, 36 and 49 were rejected under 35 U.S.C. 112, first paragraph. The examiner stated:

... because the specification, while being enabling for "a navigation routing system" comprising a navigation guide 50 ... does not reasonably provide enablement for one skilled in the art to make the same invention and shall set forth the best mode contemplated by the inventor of carrying out this invention. [emphasis in original]

(Final Office Action, page 2, section 4)

The examiner then focused on the claimed element of "automatically determining" and that it required "software with codes" (Office Action, bottom of page 2). It was recognized in the Office Action that the specification discloses that "the navigation guide 50 may comprise software, hardware, or a combination of

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software and hardware' (specification page 5, paragraph [0015]). The rejection then concluded that 'the specification does not enable any person skill in the art to duplicate the disclosure commensurate in scope with these pending claims' (Office Action, page 3, lines 1-3).

Applicant respectfully disagrees. The specification from page 3-5 and also starting on page 5, paragraph [0015] discloses very detailed embodiments of the navigation system, its components, and its functions. Furthermore, figure 1 provides a detailed component diagram and figures 2-3 provide detailed flow charts of functionality.

Applicant submits that when an invention can be implemented in software, the best mode requirement is satisfied by disclosing the functions of the software. No software code is necessary. This principle is well settled in law by the Federal Circuit and MPEP 2163 clearly recites this:

MPEP 2163 Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, para. 1, "Written Description" Requirement

Compare Forer Corp. v. General Electric Co., 107 F.3d 1543, 1549, 41 USPQ2d 1601, 1605 (Fed. Cir. 1997) ("As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed. *** Thus, flow charts or source code listings are not a requirement for adequately disclosing the functions of software.").

(MPEP 2163 Section "A. Original Claims" second paragraph, last sentence)

The present specification clearly discloses the functions of the software and even includes flow charts, which are not necessary according to the *Forer Corp.* case and MPEP 2163. Therefore, the specification satisfies all requirements of 35 U.S.C. §112. *Id.* paragraph, and is enabling. The rejection is not warranted in this case and should be withdrawn.

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The Present Amendment

The amendment to claims 2-3 are supported by, for example, page 3, paragraph [0012] of the specification. Thus no new matter has been added.

The amendment to independent claim 49 is supported by, for example, page 4, paragraph [0014] of the specification. Thus no new matter has been added.


The amendments to the other claims are also supported by, for example, pages 3-5 of the specification. Thus no new matter has been added.

Applicant respectfully requests that the present amendments be entered since the final rejection is premature and should be withdrawn.

Conclusion

For the reasons set forth above, claims 1-15, 30-42, and 49-54 are now in condition for allowance. An early allowance of the claims is earnestly solicited.

Respectfully submitted,


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